

Amendment and Response  
Serial No. 09/597,456  
Page 3 of 5

together by knitting so as to hold the yarns in fixed positions relative to one another. (Vane, col. 2, lines 64-69).

U.S. Patent No. 5,910,458 (Beer et al.) discloses a mat adapted to reinforce a thermosetting matrix material. The mat includes a primary layer of generally parallel, essentially continuous glass fiber strands oriented generally parallel to a longitudinal axis of the mat. A secondary layer includes a plurality of randomly oriented, generally continuous glass fiber strands. The strands of the primary layer are entangled with the strands of the secondary layer by needling to form the mat.

Vane and Beer teach different methods of securing the reinforcing fibers in a fixed relationship relative to one another. Beer does not teach stitching the reinforcing fibers because the reinforcing fibers are secured by a needled batting material. Vane does not teach a needled batting material because the reinforcing fibers are secured by stitching.

As acknowledged on page 3 of the Office Action, Vane does not disclose a batting layer containing fibers. Applicants respectfully submit that there is no teaching or motivation to modify Vane to include the batting material, in part, because Vane has solved the problem of securing the reinforcing fibers by stitching.

It is not relevant that all of the elements of the claimed invention may be found in Vane and Beer. What must be found obvious to sustain the present rejection is the claimed combination." Kimberly-Clark Corp. v. Johnson & Johnson, 745 F.2d 1437, 1448, 223 USPQ 603, 609-10 (Fed. Cir. 1984). The prior art items themselves must suggest the desirability and thus the obviousness of making the combination without the slightest recourse to the teachings of the present application. Without such independent suggestion, the prior art is to be considered merely inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd., 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991). Therefore, "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the

Amendment and Response  
Serial No. 09/597,456  
Page 4 of 5

desirability, and thus the obviousness, of making the combination.'" See In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)). It is also well established law that one cannot pick and choose among individual parts of assorted prior art references as a mosaic to recreate a facsimile of a claimed invention in order to show the alleged obviousness of this invention. Akzo N.V. v. United States International Trade Commission, 808 F.2d 1471, 1481, 1 U.S.P.Q.2d 1241, 1246 (Fed. Cir. 1986). Applicants submit that neither Vane nor Beer contain the required suggestion for the proposed combination.

As discussed above, Vane accomplishes securing the reinforcing fibers with stitching. Teaching away from the claimed invention is the antithesis of the art's suggesting that the person of ordinary skill go in the claimed direction. Essentially, teaching away from the art is a per se demonstration of lack of prima facie obviousness. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Nielson, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987). Applicants submit that the stitching solution disclosed in Vane teaches away from the needled batting layer disclosed in Beer. Similarly, the needled batting layer of Beer teaches away from the stitching solution disclosed in Vane.

Applicant respectfully submits that claims 13-28 and 65-102 distinguish over the cited references. Applicant respectfully requests a Notice of Allowance to be issued in this case.

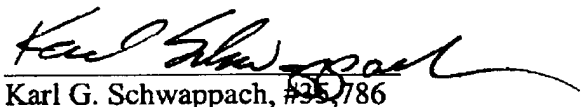
Amendment and Response  
Serial No. 09/597,456  
Page 5 of 5

If the Examiner deems any issue remaining after consideration of this response, he is invited to call the undersigned and expedite any remaining prosecution.

Respectfully Submitted,

KENNETH D. BEER et al.

By:



Karl G. Schwappach, #35,786  
FAEGRE & BENSON LLP  
2200 Wells Fargo Center  
90 South Seventh Street  
Minneapolis, MN 55402-3901  
612/766-7773

Dated: December 2, 2002

M2:20506411.01

**OFFICIAL**

**FAX RECEIVED**

**DEC 03 2002**

**GROUP 1700**